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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,180	02/25/2002	Bruce L. Davis	P0585	1232

23735 7590 10/18/2006

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/086,180	Applicant(s) DAVIS, BRUCE L.	
	Examiner David Lazaro	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/2/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed 08/03/2006.
2. Claims 1-15 and 27-36 are pending in this office action.

Response to Amendment/Arguments

3. Based on applicant's remarks, the examiner withdraws the rejection of claims 1-15 under 35 U.S.C. 112, first paragraph.
4. Applicant's arguments with respect to the rejection of claims 1-15 under 35 U.S.C. 102 and 103 have been considered but are moot in view of the new ground(s) of rejection.

Election/Restrictions

5. Newly submitted claims 29-32 and 34-36 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
Based on the amendment and applicants new claims, the new relationship for restriction is as follows:
6. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, 27, 28 and 33, drawn to methods of distributing a trusted image, classified in class 709, subclass 217.
 - II. Claims 16-20, 29, 30, 34 and 35, drawn to a document printing method, classified in class 358, subclass 3.28.

III. Claims 21-26, 31, 32 and 36, drawn to a method of providing an access credential for a person, classified in class 713, subclass 176.

7. This application contains claims directed to the following patentably distinct species: Group I is directed towards the species embodied by a user electronically soliciting an agency for an image of the user and electronically receiving the image. Group II is directed towards the species embodied by the extraction of information from a steganographically encoded image and printing the information on a document. Group III is directed towards the species embodied by the receiving of code data that is encoded in a graphic for the explicit use as an access credential. The species are independent or distinct because;

8. Group I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as allowing individuals to electronically request an image of themselves from a government agency and the government agency electronically transmitting the image to the individual. See MPEP § 806.05(d).

9. Group I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as steganographically encoding a graphic such that it can be used as an access credential to gain access to a restricted area.. See MPEP § 806.05(d).

10. Group II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as using steganographically encoded data on a digital photo to generate text to be printed with the digital photo. See MPEP § 806.05(d).

11. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 is generic.

12. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

13. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-26, 29-32 and 34-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

14. Claim 30 is objected to because of the following informalities: The dependency for claim 30 was omitted. The examiner will consider claim 30 as being dependent on claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-3, 5, 10, 11, 27 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,760,916 by Dellert et al. (Dellert).

17. With respect to Claims 1, 10 and 33, Dellert teaches a method of printing a trusted image, comprising:

an individual user electronically contacting an agency, soliciting an image depicting the user stored in an archive maintained by said agency (Col. 8 line 53 - Col. 9 line 6, Col. 9 lines 25-34 and Col. 1 lines 4-9: user electronically contacts hub station, which archives the users images, to request an image or images. The scope of photography and user's photographs would include images depicting the user).

electronically receiving said image from said contacted agency (Col. 9 lines 23-34);

printing a document incorporating said image (Col. 9 lines 23-49).

Dellert does not explicitly state the agency maintaining the archive is a governmental agency. However, as noted by applicant (Page 7 of the remarks), one skilled in the art would recognize that an image archive is the same regardless of the entity maintaining the image archive. As such, an agency maintaining the image archive as taught by Dellert would be the same as a governmental agency maintaining an image archive.

Based on this, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have an individual user electronically contacting a governmental agency, soliciting an image depicting the user stored in an archive maintained by said governmental agency and electronically receiving said image from said contacted governmental agency. It is desirable to allow users to remotely access images regardless of the type of agency storing those images (Col. 2 lines 11-27). The type of agency/entity is descriptive and does not form a patentable distinction.

18. With respect to Claim 2, Dellert further teaches it is the individual user who receives said image and prints said document (Col. 9 lines 23-34).

19. With respect to Claim 3, Dellert further teaches said document is a photo identification document (Col. 3 lines 23-49).

20. With respect to Claim 5, Dellert does not explicitly disclose the governmental agency is a motor vehicle licensing agency, and the image is a driver license photo.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The soliciting, receiving

and printing would be performed the same regardless of the agency being a motor vehicle licensing agency and the image being a driver license photo. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the governmental agency be a motor vehicle licensing agency, and the image being a driver license photo because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

21. With respect to Claim 11, Dellert teaches a method of distributing a trusted image, comprising:

at an agency, receiving an electronic request for an archived personal image from an individual depicted in said image (Col. 8 line 53 - Col. 9 line 6, Col. 9 lines 25-34 and Col. 1 lines 4-9: hub station, which archives the users personal images, electronically receives user request for an image to request an image or images. The scope of photography and user's photographs would include images depicting the user);

electronically transmitting said image to said individual (Col. 9 lines 23-34).

22. With respect to Claim 27, Dellert teaches printing said document at a home of said individual user (Col. 9 lines 23-34).

23. Claims 4, 6-9, 12-15 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dellert in view of U.S. 5,841,886 by Rhoads (Rhoads).

24. With respect to Claim 4, Dellert does not explicitly disclose said document is an identification badge.

Rhoads teaches identification documents can include identification badges (Col. 1 lines 27-34 and Col. 6 lines 44-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said document is an identification badge. One would be motivated to have this as identification badges are desirable and widely used for identification purposes (In Rhoads: Col. 1 lines 27-34 and Col. 6 lines 44-57).

25. With respect to Claim 6, Dellert does not explicitly disclose said image is processed with an identification code by the governmental agency.

Rhoads teaches an image can be processed with an identification code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is processed with an identification code. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

26. With respect to Claim 7, Dellert teaches all the limitations of Claim 1, but does not explicitly disclose said image is digitally watermarked with a plural-bit code by the governmental agency.

Rhoads teaches an image can be digitally watermarked with a plural-bit code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is digitally watermarked with a plural-bit code by the governmental agency. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

27. With respect to Claim 8, Dellert further teaches said plural bit code serves to identify the individual user's name (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

28. With respect to Claim 9, Dellert further teaches said plural-bit code comprises an index into a data structure in which the individual user's name is stored (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

29. With respect to Claim 12, Dellert teaches all the limitations of Claim 11, but does not explicitly disclose processing said image with an identification code prior to said electronic transmission.

Rhoads teaches an image can be processed with an identification code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated

by Rhoads such that said image is processed with an identification code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

30. With respect to Claim 13, Dellert teaches all the limitations of Claim 11, but does not explicitly disclose digitally watermarking said image with a plural-bit code prior to said electronic transmission.

Rhoads teaches an image can be digitally watermarked with a plural-bit code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is digitally watermarked with a plural-bit code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

31. With respect to Claim 14, Dellert further teaches said plural bit code serves to identify the individual user's name (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

32. With respect to Claim 15, Dellert further teaches said plural-bit code comprises an index into a data structure in which the individual user's name is stored (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

33. With respect to Claim 28, Dellert does not explicitly disclose obtaining from a database maintained by said governmental agency a name of said individual user, and printing said obtained name on the document.

Rhoads teaches obtaining from a database a name of said individual user and printing said obtained name on the document (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).


It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that it further comprises obtaining from a database maintained by said governmental agency a name of said individual user, and printing said obtained name on the document. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

Conclusion

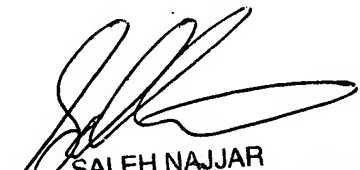
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



David Lazaro
October 12, 2006



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER